

**REMARKS**

Applicant has cancelled the non-elected claims without prejudice for filing divisional applications.

The present invention provides a content reproduction apparatus, method and program that enables a relatively sophisticated control of the display of commercial content received from a source, such as a cable channel, to be selectively displayed in accordance with a number of different conditions to assist in balancing the commercial demands of advertising revenue, and the viewing pleasure of the subscriber to thereby increase the effectiveness of the advertisement in this environment. For example, as set forth in the flow chart of Figure 6 and in the description in our specification on pages 17-20, the particular user input of a specified type of user instruction such as a power-off instruction can enable the display of the commercial content for longer than would be the case with other types of user instructions. Thus, making it possible to perform extended display of commercial content, that will fit within a time period when the user wishes to end viewing the broadcast program. Additionally, the commercial content can be matched with a specific display time period, relative to the desired broadcast programming content. Additionally, the fact that a subscriber has paid an additional sum for programming content, e.g., pay broadcast, can also determine the appropriate time periods that commercials can be displayed, while still addressing the needs of the advertisers that require an opportunity to get the attention and viewing of the subscriber. Thus, the present invention permits controlling a reproduction time period of a stored commercial content in accordance with various received user instructions and events, that are not taught nor suggested by any of the references of record.

The Grossman et al., U.S. Patent No. 5,907,321 sought to address a problem in the prior art that would not permit advertising information to be updated in a subscriber's television

system, see column 2, line 6-8. Referring to Figure 1, a plurality of Subscriber Systems 16a-n is disclosed and the television cable box or subscriber unit, can then be set to one of an on or off condition for displaying commercial content. The Grossman et al. reference can down load commercial content to a cable top box, such as in a form of a corporate logo, trademark or textual message, see column 3, line 35-45. The occurrence of a user switching a channel with a pre-determined time period, or Inter Channel Interval (ICI), can be identified and used as the activation to insert the commercial content. As noted on column 3, lines 56-65, a subscriber can get a lower cost service if he would be willing to accept his subscriber unit to be activated to an "on condition", that is, display image indicator 28a-n is set to ON. To address the issue of channel surfing, a pre-determined period of time after a first display of commercial content will be delayed, if there are subsequent channel changes.

The Office Action specifically referred to the ROM 40 and column 4, lines 55-58 and column 6, lines 11-18, as respectively teaching claim elements of a registered instruction storing means, an instruction receiving means, and an instruction judging means, in accordance with our original claims. Applicants respectively traverse the contention that, each of these elements are anticipated by the teaching in the Grossman et al. reference. A control program is basically stored within ROM 40, as noted on column 6, line 11-18. A microprocessor simply accesses the control program to implement the stored program. As set forth in column 7, line 3, the microprocessor also accesses the display image indicator 28a from RAM 44, to determine when a visual image is to be displayed. Accordingly, upon the recognition of a channel change or ICI signal, and apparently a flag set for an "off or on condition" of the display image indicator, a commercial will be displayed during the available time period.

As the Grossman et al. reference neither discloses nor suggests the unique effects that can

be achieved by a reproduction time control unit, in the manner set forth in our now amended claims.

As can be appreciated, any form of a subjective control of the display and duration of the time periods for displaying advertisement relative to broadcast content data, is a highly sensitive issue, and has been addressed by a number of engineers and programmers in this field. It is respectfully submitted that the solution set forth by the present claims, provides an improvement in this field that is worthy of patent protection.

As set forth in the newly drafted claims 20 and 21, a commercial content output notification unit uniquely interfaces with other claim elements that are disclosed in a format that does not use "means for" structure of the 6th Paragraph, of 35 U.S.C. § 112 to permit automatic determinations of pre-determined time periods of appropriate duration for commercial content reproduction relative to broadcast program content. Grossman et al. reference does not anticipate nor render obvious these claims.

The Office Action further contended that claims 9, 10, 12 and 13, would be obvious over the Grossman et al. reference when further viewed from the teachings of the Eyer et al., U.S. Patent No. 6,588,015.

Apparently, the Office Action is referring to the received data 1040 of Figure 10, and the capability of a broadcast interactive digital radio system, to provide different selective levels of service from a free or basic service level, to a premium service level with no commercials. The premium service is achieved by providing data that can indicate access points for the program segments, and thereby avoid or skip over commercial segments. The Office Action contended that it would be obvious to modify the Grossman system to include, in essence, a canceling means to cancel any reproduction of commercial content, while referring to the teaching on

column 16, lines 37-45, and lines 55-59. The ability to bypass, for example, by providing headers for setting forth access points in the received data stream, does not address the balance between the conflicting demands of the advertisers, and the varying requirements of either a paying or a non-paying subscriber, while still permitting the display of the commercials, but only at prescribed time durations or periods, that can be automatically determined by taking into consideration, attributes of the broadcast program and specific user instructions as correlated with stored broadcast content information, subscription information and pre-selected information. The Eyer et al. reference does not address or suggest any elements that could be equated to the reproduction time control unit of amended claims 7, 17 and 19. Additionally, it does not address the claim elements set forth in the newly drafted claims 20 and 21 in a manner defined to enable the advantages of the present invention.

Dependent claims 11 and 14 were further rejected over the combination of Grossman et al., Eyer et al. and Blahut et al. U.S. Patent No. 5,532,735. The Office Action acknowledged that neither Grossman et al, nor Eyer et al provide the attribute data information, as defined in our claims, to permit an automatic allocation of commercial content. The Office Action, however, contended that the Blahut et al. reference was in the environment of the interactive television system, and permitted a viewer to select a VOD or pay program, to determine whether or not to cancel a set of advertisements during that program. Based upon such a teaching, the Office Action concluded that, the advantage of allowing a subscriber a choice in advertising and billing amounts for a specific paid program from the Blahut teaching, was sufficient to supplement the deficiencies in the Grossman et al and Eyer et al. reference.

Applicants respectfully traverse this assertion, and submit the only teaching to even attempt to collect such references, would be hindsight from the present application. Further,

even if accepting the appropriateness of a teaching reference for assembling these three references, it would still not provide the features set forth in the amended and new claims defined herein.

Even if hypothetically, the prior art *may* be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

[T]he level of skill in the art is a prism or lens through which a judge or jury views the prior art and the claimed invention. This reference point prevents these deciders from using their own insight or, worse yet, hindsight, to gauge obviousness. Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment. Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process. *Al-Site Corp. v. VSI International, Inc.*, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999) (citations omitted).

The Federal Circuit addressed this issue in the case of *In re Rouffet*, 47 U.S.P.Q.2d 1453, 149 F.3d 1350 (Fed. Cir. 1998). In *Rouffet*, the Court noted that virtually all inventions are combinations of old elements. It concluded that:

an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' *Id.* at 1357.

The court pointed to the absence of any teaching *in the cited references* for making the proposed modifications, and found that the Board had *reversibly erred* in determining that the invention was rendered obvious because there was no identification of motivation to choose the

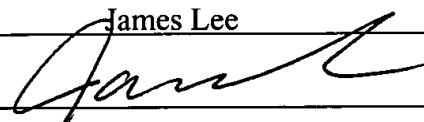
selected features.

In summary, it is respectfully submitted that the amended claims, and the newly drafted claims 20-21, define a unique contribution to this art, that is neither taught nor suggested, within this technological field.

It is respectfully submitted that the case is now in condition for allowance in an early identification of the same is requested. If the Examiner believes that a telephone interview will help further the prosecution of this case, the undersigned attorney can be contacted at the listed telephone number.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 14, 2004.

By: James Lee

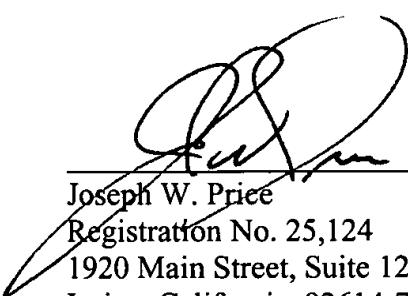


Signature

Dated: June 14, 2004

Very truly yours,

**SNELL & WILMER L.L.P.**



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